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Date of Deposit: August 20, 2007

3697  
BRINKS  
HOFER  
GILSON  
& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln of: Neal Brady et al.

U.S. Patent Application Serial  
No.: 10/001,237

RCE Filing  
Date: March 6, 2006

U.S. Filing  
Date: October 30, 2001

For: NETWORK AND METHOD FOR TRADING DERIVATIVES

Attorney Docket No.: 4672/363

Examiner: Frantzy Poinvil

Group Art Unit: 3692

Confirmation No.: 9272

Mail Stop Patent Ext  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Amended Request for Reconsideration of Patent Term Adjustment Decision Pursuant to 37 C.F.R. § 1.705(b)  
☒ Return Receipt Postcard

Fee calculation:

- ☐ No additional fee is required.  
☐ Small Entity.  
☐ An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).  
☐ A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_).  
☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x \$100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+\$360=	
					Total	\$		Total	\$

Fee payment:

- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.  
☐ Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).  
☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

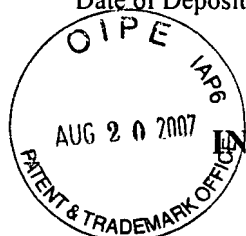
Respectfully submitted,

*Scott Timmerman*  
Scott A. Timmerman (Reg. No. 55,678)

August 20, 2007  
Date

"Express Mail" mailing label number: EM 091194122 US

Date of Deposit: August 20, 2007



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Neal Brady et al.

Serial No: 10/001,237

Examiner: Frantzy Poinvil

RCE Filing  
Date: March 6, 2006

Filed: October 30, 2001

Group Art Unit: 3628

For: NETWORK AND METHOD FOR  
TRADING DERIVATIVES

Confirmation No. 9272

Attorney Docket No.: 4672/363

**AMENDED REQUEST FOR RECONSIDERATION OF PATENT TERM  
ADJUSTMENT DECISION PURSUANT TO 37 C.F.R. § 1.705(b)**

Mail Stop Patent Ext  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

A Request for Reconsideration of the Patent Term Adjustment decision was filed on April 6, 2007. That Request was dismissed on July 13, 2007 (see Exhibit E). In response to the dismissal of Applicant's original Request, Applicant is filing this amended Request. In particular, as noted below, the Applicant hereby certifies that each item of information

contained in the information disclosure statement (1/8/07 I.D.S.) was first cited in **any** communication from a foreign patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of the information disclosure statement (1/8/07 I.D.S.).

A notice of allowance was issued for the present application on March 13, 2007 indicating that the issue fee is due on June 13, 2007. The issue fee is being submitted for the present application in conjunction with this request for reconsideration of the patent term adjustment. The Patent Application Information Retrieval (PAIR) system and the notice of allowance both indicate a patent term adjustment that was calculated by the U.S. Patent office pursuant to 37 C.F.R. 1.701 of 729 days. A copy of Notice of Allowance for the present application is included herewith as Exhibit A.

Applicant's Attorney believes that the patent term adjustment should be 901 days. For the reasons stated herein, reconsideration of the patent term adjustment is respectfully requested pursuant to 37 C.F.R. 1.705(b). Please charge the petition fee pursuant to 37 C.F.R. § 1.18(e) to Deposit Account No. 23-1925. Please charge any additional fee required or credit for any excess fee paid to Deposit Account No. 23-1925. A duplicate copy of this Petition is attached.

The patent term adjustment for the present application was calculated by the U.S. Patent and Trademark Office based on activities and associated dates detailed in the Patent Application Information Retrieval (PAIR) system Patent Term Adjustment History, attached as Exhibit B. Applicant's Attorney believe that an error in the PAIR system Patent Term Adjustment History may have resulted in an incorrect patent term adjustment for the present application as described in detail below. The present application is not subject to a terminal disclaimer.

**Period of adjustment pursuant to 37 C.F.R. § 1.703****Period of adjustment pursuant to 37 C.F.R. § 1.703(d)**

The period of adjustment pursuant to 37 C.F.R. § 1.703(d) is not limited by the filing of an Information Disclosure Statement in compliance with §§ 1.97 and 1.98 if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement..

An Information Disclosure Statement was filed on January 8, 2007 (“1/8/07 I.D.S.”) and is attached as Exhibit C. The 1/8/07 I.D.S. included the following statement: “For purposes of 37 C.F.R. §1.704(d), Applicant certifies that each item of information contained in this Statement was first cited in a communication from a foreign patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of this Statement (a copy of any foreign communication first citing a listed reference is attached for the Examiner's reference).” Exhibit C, pp. 1-2. In correction of the dismissal, dated July 13, 2007 (attached as Exhibit E), of Applicant’s original Request of April 6, 2007, the Applicant hereby certifies that each item of information contained in the information disclosure statement (1/8/07 I.D.S.) was first cited in **any** communication from a foreign patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of the information disclosure statement (1/8/07 I.D.S.).

The communication from the foreign patent office was dated December 18, 2006 as

evidenced by the PCT Search Report, attached as Exhibit D. The submission date of December 18, 2006 is shown on page 2 of Exhibit D. The 1/8/07 I.D.S. (Exhibit C) was filed on January 8, 2007, which is less than 30 days (30 days would be January 18, 2007) after receipt of the communication from the PCT (Exhibit D). Accordingly, under 37 C.F.R. §1.704(d) the statement in the 1/8/07 I.D.S. (Exhibit C, pp. 1-2) affirming this fact should result in NO applicant delay. However, in the PTO calculation (Exhibit B), 172 days of Applicant delay are listed as a result of the 1/8/07 I.D.S. The 172 days of Applicant delay is therefore improper under 37 C.F.R. §1.704(d) and should be removed. According to our calculations, we believe that the patent term adjustment should be 901 days ( $729+172=901$ ), instead of the 729 days indicated on the Notice of Allowance attached as Exhibit A.

Applicant's Attorney expects that additional delay can reasonably be expected prior to a patent issuing for the present application. Applicant's Attorney therefore requests re-computation of the period of adjustment pursuant to 37 C.F.R. § 1.703 upon identification of the date of issue of the patent of the present application to reflect this delay. With this request, Applicant's Attorney further reserves the right to request reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d) if the term of the issued patent is believed to be extended or adjusted incorrectly.

### Conclusion

It is respectfully asserted that the patent term adjustment determined by the U.S. Patent and Trademark Office for the present application may not be correct. Accordingly, Applicant's Attorney respectfully requests the U.S. Patent and Trademark office to reconsider, and make revisions to the PAIR system Patent Term Adjustment History in view of

the previous remarks. In addition, it is respectfully requested that the patent term adjustment be re-calculated by the U.S. Patent and Trademark Office in view of the above remarks. Office personnel are invited to contact the undersigned attorney for the Applicant's via telephone if such communication would be beneficial in fulfilling this request.

Respectfully submitted,

Dated: August 20, 2007

A handwritten signature in cursive script, reading "Scott Timmerman", written in black ink over a horizontal line.

Scott A. Timmerman  
Registration No. 55,678  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

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# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

## NOTICE OF ALLOWANCE AND FEE(S) DUE

49664 7590 03/13/2007  
BRINKS HOFER GILSON & LIONE / CME  
P.O. BOX 10395  
CHICAGO, IL 60610



EXAMINER	
POINVIL, FRANTZY	
ART UNIT	PAPER NUMBER

3692  
DATE MAILED: 03/13/2007

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,237	10/30/2001	Neal Brady	4672-363	9272

TITLE OF INVENTION: NETWORK AND METHOD FOR TRADING DERIVATIVES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$700	\$300	\$0	\$1000	06/13/2007

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

### HOW TO REPLY TO THIS NOTICE:

#### I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.
- B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

- A. Pay TOTAL FEE(S) DUE shown above, or
- B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.



# **PART B - FEE(S) TRANSMITTAL**

Complete and send this form, together with applicable fee(s), to: Mail

**Mail Stop ISSUE FEE**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, Virginia 22313-1450**  
 or Fax **(571)-273-2885**

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

49664 7590 03/13/2007  
**BRINKS HOFER GILSON & LIONE / CME**  
**P.O. BOX 10395**  
**CHICAGO, IL 60610**



**Certificate of Mailing or Transmission**  
 I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,237	10/30/2001	Neal Brady	4672-363	9272

**TITLE OF INVENTION: NETWORK AND METHOD FOR TRADING DERIVATIVES**

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$700	\$300	\$0	\$1000	06/13/2007

EXAMINER	ART UNIT	CLASS-SUBCLASS
POINVIL, FRANTZY	3692	705-037000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).  
☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.  
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list  
 (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,  
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

**3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)**

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

**4a. The following fee(s) are submitted:**

- ☐ Issue Fee  
☐ Publication Fee (No small entity discount permitted)  
☐ Advance Order - # of Copies \_\_\_\_\_

**4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)**

- ☐ A check is enclosed.  
☐ Payment by credit card. Form PTO-2038 is attached.  
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

**5. Change in Entity Status (from status indicated above)**

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,237	10/30/2001	Neal Brady	4672-363	9272
49664	7590	03/13/2007		
BRINKS HOFER GILSON & LIONE / CME P.O. BOX 10395 CHICAGO, IL 60610				
EXAMINER POINVIL, FRANTZY				
ART UNIT      PAPER NUMBER				
3692				
DATE MAILED: 03/13/2007				

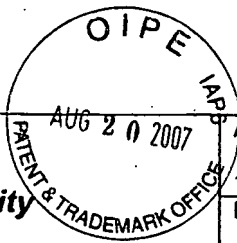
## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 729 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 729 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.



# Notice of Allowability

Application No.

10/001,237

Examiner

Frantzy Poinvil

Applicant(s)

BRADY ET AL.

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the response filed 7/20/06.
2. ☒ The allowed claim(s) is/are 21-60.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

FRANTZY POINVIL  
PRIMARY EXAMINER

Au 36 92

## DETAILED ACTION

### *Allowable Subject Matter*

1. Claims 21-60 are allowable over the art of record.

The abstract has been changed to:

- - A computer network and method for electronically trading derivatives. The system includes networks and methods where a control or network managing station in the network acts as a facilitator for the market makers and subscribers to make a trade at an Exchange. In another embodiment the network managing station consummates the trade between a market maker and a subscriber by matching binding quotes and orders and clears the trade at an Exchange. The computer network for electronically trading derivative uses: (a) network managing station; (b) one or more market maker stations; (c) one or more subscriber stations; (d) one or more Exchanges. The network managing station connects market makers and subscribers for making real time indicative quotes, issuing requests for quotes, obtaining binding quotes and wherein the market maker and subscriber are in communication with an Exchange for sending binding quotes and orders to the Exchange for clearing and confirming transactions. - -

2. The following is an examiner's statement of reasons for allowance:

The prior art taken alone or in combination failed to teach or suggest:

"the requestor may cause transmission of the request for an indicative quote for the at least one product via the network to the identified market maker station of the plurality of market maker stations, the remaining of the plurality of market maker stations not receiving the request for the indicative quote, and whereby the identified market maker station may respond to the request for indicative quote with an indicative quote for only the at least one product and the at least identified market maker station may respond to the request for a binding quote with a binding quote for only the at least one product" as recited in independent claim 21.

The prior art taken alone or in combination failed to teach or suggest a function of "enabling communications between the subscriber station and at least the identified market maker station of the plurality of market maker stations such that the subscriber station may cause transmission of request for a binding quote for the at least one product to the at least identified market maker station and the at least identified market maker station may respond with a binding quote only for the at least one product" as recited in independent claim 31.

The prior art taken alone or in combination failed to teach or suggest "third logic stored in the third memory and executable by a third processor to generate the request for identification of the market maker station associated with a market maker interested in quoting for the at least one product of the plurality of products and transmit the request to the at least one network managing station via the network, and cause transmission of the request for an indicative quote for the at least one product to the identified market maker station via the network in response to the enabling of

Art Unit: 3692

communications by the at least one network managing station, the third logic being further operative to cause transmission of the request for a binding quote for the at least one product to the at least identified market maker station via the network in response to the enabling of communications by the at least one network managing station" as recited in independent claim 40.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 3692**

FP  
November 7, 2006

<b>Issue Classification</b> 	Application/Control No. 10/001,237 Examiner Frantzy Poinvil		Applicant(s)/Patent under Reexamination BRADY ET AL. Art Unit 3692
	AUG 20 2007 PATENT & TRADEMARK OFFICE		

ISSUE CLASSIFICATION									
ORIGINAL				CROSS REFERENCE(S)					
CLASS		SUBCLASS		CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)				
705		37		705	36R				
INTERNATIONAL CLASSIFICATION									
G	O	6	Q	40/00					
				/					
				/					
				/					
				/					
(Assistant Examiner) (Date) <i>Patricia Lewis</i> 12/4/06 (Legal Instruments Examiner) (Date)				(Primary Examiner) (Date) <i>Frantzy Poinvil</i> 11/7/06				Total Claims Allowed: 40 O.G. Print Claim(s) 1 O.G. Print Fig. 2A	

<input type="checkbox"/> Claims renumbered in the same order as presented by applicant				<input type="checkbox"/> CPA				<input type="checkbox"/> T.D.				<input type="checkbox"/> R.1.47			
Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original		
	1	11	31		61		91		121		151		181		
	2	12	32		62		92		122		152		182		
	3	13	33		63		93		123		153		183		
	4	14	34		64		94		124		154		184		
	5	15	35		65		95		125		155		185		
	6	16	36		66		96		126		156		186		
	7	17	37		67		97		127		157		187		
	8	18	38		68		98		128		158		188		
	9	19	39		69		99		129		159		189		
	10	20	40		70		100		130		160		190		
	11	21	41		71		101		131		161		191		
	12	22	42		72		102		132		162		192		
	13	23	43		73		103		133		163		193		
	14	24	44		74		104		134		164		194		
	15	25	45		75		105		135		165		195		
	16	26	46		76		106		136		166		196		
	17	27	47		77		107		137		167		197		
	18	28	48		78		108		138		168		198		
	19	29	49		79		109		139		169		199		
	20	30	50		80		110		140		170		200		
1	21	31	51		81		111		141		171		201		
2	22	32	52		82		112		142		172		202		
3	23	33	53		83		113		143		173		203		
4	24	34	54		84		114		144		174		204		
5	25	35	55		85		115		145		175		205		
6	26	36	56		86		116		146		176		206		
7	27	37	57		87		117		147		177		207		
8	28	38	58		88		118		148		178		208		
9	29	39	59		89		119		149		179		209		
10	30	40	60		90		120		150		180		210		



**Search Notes**

Application/Control No.

10/001,237

Examiner

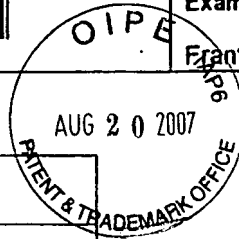
Frantzy Poinvil

Applicant(s)/Patent under  
Reexamination

BRADY ET AL.

Art Unit

3692

**SEARCHED**

Class	Subclass	Date	Examiner
705	30-42	11/7/2006	FP

**INTERFERENCE SEARCHED**

Class	Subclass	Date	Examiner
705	30-42	11/7/2006	FP

**SEARCH NOTES  
(INCLUDING SEARCH STRATEGY)**

	DATE	EXMR
See the attached NPL and West searches.	11/7/2006	FP

# Index of Claims



AUG 20 2007

U.S. PATENT & TRADEMARK OFFICE

Application/Control No.

10/001,237

Examiner

Frantzy Poinvil

Applicant(s)/Patent under Reexamination

BRADY ET AL.

Art Unit

3692

✓	Rejected
=	Allowed

-	(Through numeral) Cancelled
+	Restricted

N	Non-Elected
I	Interference

A	Appeal
O	Objected

Claim		Date			
Final	Original	11/7/06			
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Claim		Date			
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31	51	=			
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CONFIRMATION NO. 9272

Bib Data Sheet

<b>SERIAL NUMBER</b> 10/001,237	<b>FILING OR 371(c) DATE</b> 10/30/2001 <b>RULE</b>	<b>CLASS</b> 705	<b>GROUP ART UNIT</b> 3692	<b>ATTORNEY DOCKET NO.</b> 4672-363
------------------------------------	-----------------------------------------------------------	---------------------	-------------------------------	----------------------------------------

**APPLICANTS**  
 Neal Brady, Evanston, IL;  
 Noah Carey, Evanston, IL;  
 William R. Erwin, Chicago, IL;  
 John Gilmore, Burr Ridge, IL;  
 Michael Quattrocki, Chicago, IL;  
 Frank Stone, Chicago, IL;  
 Mark Thornburgh, West Chicago, IL;

**\*\* CONTINUING DATA \*\*\*\*\***  
 This appln claims benefit of 60/244,311 10/30/2000

**\*\* FOREIGN APPLICATIONS \*\*\*\*\***

**IF REQUIRED, FOREIGN FILING LICENSE GRANTED\*\* SMALL ENTITY \*\***  
**\*\* 12/20/2001**

Foreign Priority claimed <input type="checkbox"/> yes <input checked="" type="checkbox"/> no	<b>STATE OR COUNTRY</b> IL	<b>SHEETS DRAWING</b> 10	<b>TOTAL CLAIMS</b> 40	<b>INDEPENDENT CLAIMS</b> 3
-------------------------------------------------------------------------------------------------	-------------------------------	-----------------------------	---------------------------	--------------------------------

35 USC 119 (a-d) conditions ☐ yes ☒ no ☐ Met after  
 met

Verified and Acknowledged FFP/INN PP  
 Examiner's Signature Initials

**ADDRESS**  
 49664

**TITLE**  
 NETWORK AND METHOD FOR TRADING DERIVATIVES

<b>FILING FEE RECEIVED</b> 921	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees ( Filing ) <input type="checkbox"/> 1.17 Fees ( Processing Ext. of time ) <input type="checkbox"/> 1.18 Fees ( Issue ) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit
-----------------------------------	-------------------------------------------------------------------------------------------------------------------	---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

B

10/001,237

NETWORK AND METHOD FOR TRADING DERIVATIVES

04-03-  
2007::19:05:13**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/001,237

Filing or 371(c) Date:	10-30-2001	USPTO Delay (PTO) Delay (days):	956
Issue Date of Patent:	null	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	227
Post-Issue Petitions (days):	+0	Total PTA (days):	729
USPTO Adjustment(days):	+0	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
03-13-2007	Mail Notice of Allowance	113	
01-08-2007	Reference capture on IDS	↑	
01-08-2007	Information Disclosure Statement (IDS) Filed		172
02-01-2007	Correspondence Address Change		↑
12-04-2006	Notice of Allowance Data Verification Completed		↑
10-05-2006	Case Docketed to Examiner in GAU		↑
08-08-2006	Date Forwarded to Examiner		↑
07-20-2006	Response after Non-Final Action		↑
06-02-2006	Mail Non-Final Rejection		
05-30-2006	Non-Final Rejection		
03-06-2006	Information Disclosure Statement considered		
03-06-2006	Reference capture on IDS		
03-06-2006	Information Disclosure Statement (IDS) Filed		
03-15-2006	Date Forwarded to Examiner		
03-15-2006	Date Forwarded to Examiner		
03-06-2006	Request for Continued Examination (RCE)		
03-15-2006	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
03-06-2006	Workflow - Request for RCE - Begin		
01-25-2006	Mail Ex Parte Quayle Action (PTOL - 326)		
12-27-2005	Ex Parte Quayle Action		
10-28-2005	Date Forwarded to Examiner		
10-21-2005	Amendment after Final Rejection		
10-07-2005	Mail Final Rejection (PTOL - 326)	216	
10-03-2005	Final Rejection	↑	
05-25-2005	Date Forwarded to Examiner	↑	
11-05-2004	Response after Non-Final Action	↑	
09-17-2004	Reference capture on IDS		
02-11-2005	IFW TSS Processing by Tech Center Complete		
12-30-2004	Information Disclosure Statement (IDS) Filed		55
11-05-2004	Workflow incoming amendment IFW		
09-17-2004	Mail Non-Final Rejection	627	
09-10-2004	Record Petition Decision of Granted to Make Special	↑	
08-16-2004	Non-Final Rejection	↑	

05-07-2004	Preliminary Amendment	↑
04-26-2004	New or Additional Drawing Filed	↑
05-21-2004	Correspondence Address Change	↑
05-24-2004	Change in Power of Attorney (May Include Associate POA)	↑
05-07-2004	Workflow incoming amendment IFW	↑
05-06-2004	Case Docketed to Examiner in GAU	↑
04-04-2004	Petition Entered	↑
04-02-2004	Information Disclosure Statement (IDS) Filed	↑
04-05-2004	Preliminary Amendment	↑
04-05-2004	Workflow incoming amendment IFW	↑
04-02-2004	Workflow incoming petition IFW	↑
04-02-2004	Workflow incoming petition IFW	↑
10-31-2002	Case Docketed to Examiner in GAU	↑
10-22-2002	Preliminary Amendment	↑
04-03-2002	Application Dispatched from OIPE	↑
04-03-2002	Application Is Now Complete	↑
02-07-2002	Payment of additional filing fee/Preexam	↑
02-07-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant	↑
12-28-2001	Notice Mailed--Application Incomplete--Filing Date Assigned	↑
12-11-2001	IFW Scan & PACR Auto Security Review	↑
10-30-2001	Initial Exam Team nn	↑

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[Close Window](#)

C



01-10-07

3628

U.S.P.S. EXPRESS MAIL "POST OFFICE TO ADDRESSEE" SERVICE  
DEPOSIT INFORMATIONExpress Mail Label No.: EV 906 812 191 USDate of Deposit: January 8, 2007BRINKS  
HOFER  
GILSON  
& LIONE

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Neal Brady et al.

Appln. No.: 10/001,237

Filed: October 30, 2001

For: NETWORK AND METHOD FOR TRADING  
DERIVATIVES

Examiner: F. Poinvil

Art Unit: 3628

Attorney Docket No: 4672/363

Mail Stop Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

## TRANSMITTAL

Sir:

Attached is/are:

- ☒ Third Supplemental Information Disclosure Statement; Form PTO-1449; Copy of cited reference C2.  
☒ Return Receipt Postcard.

## Fee calculation:

- ☒ No additional fee is required.  
☐ Small Entity.  
☐ An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).  
☐ A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_).  
☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			X100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+ \$360=	
					Total	\$		Total	\$

## Fee payment:

- ☐ A check in the amount of \$\_\_\_\_\_ is enclosed.  
☐ Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.  
☐ Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).  
☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

Date

1/8/07

James L. Katz (Reg. No. 42,711)

BRINKS  
HOFER  
GILSON  
& LIONEBRINKS HOFER GILSON & LIONE  
NBC Tower - Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599





**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Appln. of: Neal Brady ET AL.

Appln. No.: 10/001,237

Filed: October 30, 2001

For: NETWORK AND METHOD FOR  
TRADING DERIVATIVES

Attorney Docket No: 4672/363

Examiner: F. Poinvil

Art Unit: 3628

**THIRD SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

In accordance with the duty of disclosure under 37 C.F.R. §1.56 and §§1.97-1.98, and more particularly in accordance with 37 C.F.R. §1.97(c), Applicants hereby cite the following reference(s):

U.S. Patent No.	Date of Publication	Patentee/Applicant/Assignee
US2003/0033240 A1	02/13/2003	Balson et al.
<b>Other Art</b>		
International Search Report PCT/US04/36206		

Applicants are enclosing Form PTO-1449 (one sheet), along with a copy of each listed reference for which a copy is required under 37 C.F.R. §1.98(a)(2). As each of the listed references is in English, no further commentary is believed to be necessary, 37 C.F.R. §1.98(a)(3). Applicants respectfully request the Examiner's consideration of the above reference(s) and entry thereof into the record of this application.

By submitting this Statement, Applicant is attempting to fully comply with the duty of candor and good faith mandated by 37 C.F.R. §1.56. As such, this Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 C.F.R. §1.56(a).

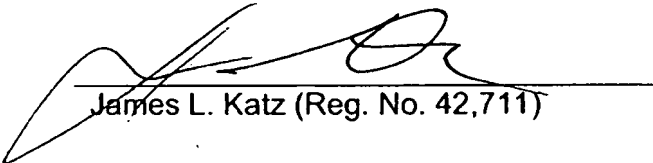
For purposes of 37 C.F.R. §1.704(d), Applicant certifies that each item of information contained in this Statement was first cited in a communication from a foreign

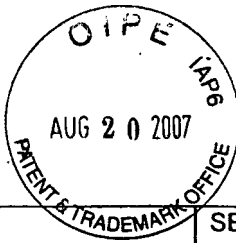
patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of this Statement (a copy of any foreign communication first citing a listed reference is attached for the Examiner's reference).

Applicant certifies under 37 C.F.R. §1.97(e)(1) that each item of information in this Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Statement (a copy of any foreign communication first citing a listed reference is attached for the Examiner's reference). Accordingly, Applicant has calculated no fee to be due in connection with the filing of this Statement. However, the Director is authorized to charge any fee deficiency associated with the filing of this Statement to a deposit account, as authorized in the Transmittal accompanying this Statement.

Respectfully submitted,

1/8/07  
Date

  
James L. Katz (Reg. No. 42,711)



FORM PTO-1449	SERIAL NO. 10/001,237	CASE NO. 4672/363
LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT (use several sheets if necessary)	FILING DATE October 30, 2001	GROUP ART UNIT 3628
APPLICANT(S): Neal Brady et al.		

## REFERENCE DESIGNATION

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER <small>Number-Kind Code (if known)</small>	DATE	NAME	CLASS/ SUBCLASS	FILING DATE
	C1	US2003/0033240 A1	02/13/2003	Balson et al.	

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER <small>Number-Kind Code (if known)</small>	DATE	COUNTRY	CLASS/ SUBCLASS	TRANSLATION YES OR NO

EXAMINER INITIAL	OTHER ART - NON PATENT LITERATURE DOCUMENTS (Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published.	
	C2	International Search Report PCT/US04/36206

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

D

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference <b>4672-422</b>	<b>FOR FURTHER ACTION</b> <small>see Form PCT/ISA/220 as well as, where applicable, item 5 below.</small>	
International application No. <b>PCT/US04/36206</b>	International filing date ( <i>day/month/year</i> ) <b>01 November 2004 (01.11.2004)</b>	(Earliest) Priority Date ( <i>day/month/year</i> ) <b>02 December 2003 (02.12.2003)</b>
Applicant <b>CHICAGO MERCANTILE EXCHANGE, INC.</b>		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 2 sheets.



It is also accompanied by a copy of each prior art document cited in this report.

**1. Basis of the Report**

a. With regard to the language, the international search was carried out on the basis of:



the international application in the language in which it was filed.



a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b))

b. ☐ With regard to any nucleotide and/or amino acid sequence disclosed in the international application, see Box No. I.

2. ☐ Certain claims were found unsearchable (See Box No. II).

3. ☐ Unity of invention is lacking (See Box No. III).

4. With regard to the title,



the text is approved as submitted by the applicant.



the text has been established by this Authority to read as follows:

5. With regard to the abstract,



the text is approved as submitted by the applicant.



the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the drawings,

a. the figure of the drawings to be published with the abstract is Figure No. 1



as suggested by the applicant.



as selected by this Authority, because the applicant failed to suggest a figure.



as selected by this Authority, because this figure better characterizes the invention.

b. ☐ none of the figures is to be published with the abstract.

# INTERNATIONAL SEARCH REPORT

International application No.

PCT/US04/36206

## A. CLASSIFICATION OF SUBJECT MATTER

IPC(7)

US CL

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 705/35, 36R

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)  
EAST

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 2001/0032163 A1 (Fertik et al) 18 October 2001, see abstract	1-26
Y	US 2003/0033240 A1 (Balson et al) 13 February 2003, see abstract	1-26

☐ Further documents are listed in the continuation of Box C.

☐ See patent family annex.

\* Special categories of cited documents:

"A" document defining the general state of the art which is not considered to be of particular relevance

"E" earlier application or patent published on or after the international filing date

"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

"O" document referring to an oral disclosure, use, exhibition or other means

"P" document published prior to the international filing date but later than the priority date claimed

"I"

later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X"

document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y"

document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art

"&"

document member of the same patent family

Date of the actual completion of the international search

28 November 2006 (28.11.2006)

Date of mailing of the international search report

18 DEC 2006

Name and mailing address of the ISA/US

Mail Stop PCT, Attn: ISA/US

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Facsimile No. (703) 305-3230

Authorized officer

Lalita M. Hamilton

Telephone No. (703) 305-2272

## NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

### INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report and the written opinion of the International Searching Authority, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only (see *PCT Applicant's Guide*, Volume I/A, Annexes B1 and B2).

The attention of the applicant is drawn to the fact that amendments to the claims under Article 19 are not allowed where the International Searching Authority has declared, under Article 17(2), that no international search report would be established (see *PCT Applicant's Guide*, Volume I/A, paragraph 296).

#### What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

**When ?** Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

#### Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

**How ?** Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

#### What documents must/may accompany the amendments ?

##### Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

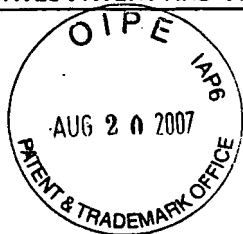
The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

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**JUL 13 2007**

**OFFICE OF PETITIONS**

In re	:
Brady, et al.	:
Application No. 10/001,237	: DECISION REGARDING
Filed: October 30, 2001	: PATENT TERM ADJUSTMENT
Patent No. 6,979,556	:
	:

This letter is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. §1.705(b)", filed April 6, 2007. Patentees request that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from seven hundred twenty-nine (729) days to nine hundred one (901) days.

The application for patent term adjustment is DISMISSED.

On April 5, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is seven hundred twenty-nine (729) days. On April 6, 2007, Applicants timely<sup>1</sup> submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is nine hundred one (901) days.

Patentees state that the patent issuing is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of seven hundred twenty-nine (729) days based on an adjustment for PTO delay of six hundred twenty-seven (627) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), two hundred sixteen (216) and one hundred thirteen (113) days

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<sup>1</sup> Applicants filed the application for patent term adjustment together with the filing of the issue fee.

pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), reduced by Applicants' delays of fifty-five (55) and one hundred seventy-two (172) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(c)(8). The adjustment of one hundred seventy-two (172) days is at issue.

A review of the application file reveals that applicants filed a Supplemental Information Disclosure Statement (IDS) on January 8, 2007, after they had previously filed a response on July 20, 2006. The IDS did not contain a proper 37 C.F.R. § 1.704(d) statement. The IDS contained a statement that "each item of information contained in this Statement was first cited in a communication from a foreign patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this Statement." § 1.704(d) states that an IDS will not be considered a failure to engage under (c)(8) if it is accompanied by a statement that "each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received" more than thirty days prior to the filing of the IDS.

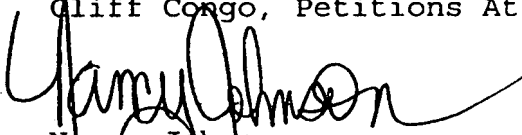
Applicants should have mirrored the language as required by § 1.704(d). Accordingly, applicant delay of one hundred seventy-two (172) days was properly assessed pursuant to 37 C.F.R. § 1.704(c)(8).

In view thereof, the correct determination of patent term adjustment is seven hundred twenty-nine (729) days.

If applicants want to make the proper assertion, then applicants may file a Request for Reconsideration of this patent term adjustment decision, with a statement mirroring the language of § 1.704(d). Patentees are given two (2) months to respond to this decision. No extensions of time will be granted under 37 C.F.R. § 1.136(a).

Receipt of the fee under 37 C.F.R. § 1.18(e) is acknowledged.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

  
Nancy Johnson  
Senior Attorney  
Office of Petitions